

REMARKS

- Claims 1 - 63 are currently pending in the present application.
- Of the pending claims, only claims 1, 28, 37, 44, 45, 48, 55, 56, 60 and 63 are independent.
- Upon entry of this amendment, which is respectfully requested for the reasons set forth below, claims 1 - 63 will remain pending.
- The specification has been amended herein to (i) more correctly claim the benefit of the prior-filed provisional application Serial No. 60/210,946; and (ii) correct inadvertent typographical errors noted during a review of the Application. No new matter has been added with these amendments.

1. Section 102 Rejection

Claim 63 stands rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,930,769 to Rose ("Rose" herein). Applicants respectfully traverse this rejection for the reasons set forth below.

Rose fails to teach each of the limitations being performed by a particular entity, as recited in claim 63. In particular, claim 63 recites a method in which a single and particular entity performs the steps of:

"receiving information concerning characteristics of shoppers";

"using the received information to select an image for viewing"; and

"receiving the selected image".

In other words, the same entity that *receives* and *uses* the received information concerning characteristics of shoppers to select an image for viewing also *receives* the selected image. Claim 63 is written from the perspective of a participant in the shopper information system of embodiments of the present invention. A participant, as defined in the specification, is "an individual who responds to a shopper's request for an opinion or who indicates a willingness to respond to shoppers' requests for opinions." Specification, page 9, first definition. In other words, a participant is not the shopper but rather an individual who, *e.g.*, provides opinions about images of shoppers. Thus, in one or more

embodiments, a participant may receive information about characteristics of shoppers who are requesting opinions, may use the information to select an image (*e.g.*, of a shopper wearing a particular garment) and may receive the selected image.

Rose discloses a system in which a customer may provide personal information to the system (*e.g.*, such as body style, measurements, and desired fashion category) and in return is provided, by the system, with an image of one or more suggested garments that the system recommends for the shopper. See, for example, Abstract. In other words, a first entity in the Rose system (the shopper) provides information about the shopper's characteristics. A second entity (the system) that is a distinct entity from the first entity (the shopper) receives this information about the shopper's characteristics. The second entity (the system) then selects an image of a garment based on the received information and, in turn, provides the selected image to the first entity (the shopper). Thus, the first entity that receives the information about characteristics of a shopper (the system) and uses the information to select an image (*e.g.*, of a recommended garment) is not the same entity that "receives the selected image". Rather, in the Rose system, the first entity (the system) that receives the characteristics of the shopper and uses the information to select an image provides the selected image and a second entity receives the selected image. The system (the entity that receives information about the shopper and uses it to select an image) does not receive the image.

As noted above, in the embodiment of claim 63, the same and single entity that receives information about characteristics of shoppers and uses the information to select an image is also the entity that receives the selected image.

In order for a prior art reference to anticipate a claim, the prior art reference must teach each of the limitations of the claim as recited in the claim as a whole. Applicants respectfully submit that claim 63, as a whole, is not anticipated by Rose because Rose does not teach each of the steps of claim 63 as being performed by a single entity. Accordingly, Applicants respectfully request that the 102(e) rejection of claim 63 over Rose be withdrawn.

2. Section 103 Rejections

2(a). Claims 1, 2, 4 – 9, 14 – 17, 22 – 24, 44 – 46, 55, 56, 58 and 59

Claims 1, 2, 4 – 9, 14 – 17, 22 – 24, 44 – 46, 55, 56, 58 and 59 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rose in view of U.S. Patent No. 6,295,551 to Roberts et al. (“Roberts” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

As a preliminary matter, Applicants traverse this rejection on the grounds that Rose and Roberts are non-analogous art. Rose is directed to the field of “fashion shopping” (col. 1, lines 5 – 6) and addresses the problem of helping a customer “select an appropriate fashion for purchase” (col. 1, lines 7 – 8). Roberts, on the other hand, is directed to the field of “coordinating Internet communication between two users” (col. 1, lines 11 – 12) and addresses the problem of allowing two users to “view and modify a copy of the same multi-media content, where any modifications made by one user are subsequently viewed by a second user” (col. 1, lines 14 – 18). A person of ordinary skill in the art, if working in the field of one of the references or working to solve a problem of one of the references, would not look to the other reference for aid. Accordingly, Applicants respectfully submit that the combination of Rose and Roberts is improper.

2.(a).(i) No Motivation to Combine

Applicants respectfully assert that Examiner has failed to make out a *prima facie* case of a motivation to combine Rose with Roberts and thus the §103(a) rejection of claims 1, 2, 4 – 9, 14 – 17, 22 – 24, 44 – 46, 55, 56, 58 and 59 is improper. The Examiner has provided one statement in support of the combination of the Rose and Roberts references. It is asserted that

“[i]t would have been obvious to one of ordinary skill at the time of [sic] the invention was made to modify Rose’s method of shopping, to include the distributing of images and receiving responses to the image, as taught by Roberts, *in order to provide a method for coordinating Internet multimedia communication such that two or more*

users can view and modify a copy of the same multi-media contents, where any modifications made by one user are subsequently viewed by a second user or other users, as well as enhancing the communication by supplementing any visual communication with audio communication (Roberts col. 1, lines 13 – 20). Thus, *it provides customer service that personalizes and simplifies the shopping process* (Rose col. 11, lines 8 – 9)". Current Office Action (paper no. 5), page 4, first full paragraph, emphasis added.

Applicants are sincerely at a loss as to how the above statement provides a reason for combining Rose with Roberts such that the combination results in Applicants' claimed embodiments.

The first italicized portion of the statement, that the combination would be obvious "*in order to provide a method for coordinating Internet multimedia communication such that two or more users can view and modify a copy of the same multi-media contents, where any modifications made by one user are subsequently viewed by a second user or other users, as well as enhancing the communication by supplementing any visual communication with audio communication* (Roberts col. 1, lines 13 – 20)", has nothing to do with Applicants' claimed embodiments but is rather a summary of what Roberts itself discloses. In fact, this portion of Examiner's statement is a direct quote from Roberts (col. 1, lines 13 – 20). None of the pending claims recite "coordinating Internet multimedia communication such that two or more users can view and modify a copy of the same multi-media contents". The claims do not recite modifying multi-media contents at all or of allowing two users to view the same multi-media contents together. Thus, this assertion appears to have nothing to do with the claimed embodiments.

Further, even if the first italicized portion of the above-quoted statement were relevant to the claimed invention, it would not motivate one of ordinary skill in the art to combine Roberts with Rose. Roberts teaches a system and method

for “coordinating Internet multimedia communication such that two or more users can view and modify a copy of the same multi-media contents...”. Thus, there is no need to add any teachings from Rose or any other reference to achieve this goal and this motivation would not have prompted one of ordinary skill in the art to combine any other method with Roberts, much less the particular method of Rose. Additionally, since Rose does not disclose any method for coordinating Internet multi-media contents, or allowing two or more users to modify or view contents together, Rose appears to add nothing to achieve the stated goal.

Regarding the second italicized portion of the above-quoted statement, that the combination of Rose and Roberts *“provides customer service that personalizes and simplifies the shopping process”*, Applicants note that this is a direct quote from Rose, describing a result of the Rose system and method (Rose, col. 11, lines 8 – 9). In other words, Rose already “provides customer service that personalizes and simplifies the shopping process”. Thus, this motivation fails because it would not prompt one of ordinary skill in the art to combine Roberts or any other teaching with Rose in order to accomplish the stated goal. Rose discloses that its system and method already accomplishes the stated goal.

Further, this motivation is very broadly stated and does not address any of the claim features. Based on this second italicized portion of the above-quoted statement, Examiner appears to be taking the position that any method and system that “provides customer service that personalizes and simplifies the shopping process” would be obvious. In this portion of the statement, as in the first portion discussed above, none of the claimed features have been addressed and no assertion has been made the combining Rose with Roberts would result in the claimed embodiments.

In conclusion, Examiner has not provided an reason why a person of ordinary skill in the art would be motivated to combine Rose and Roberts at all, much less how such a combination would result in Applicants’ claimed embodiments. Accordingly, Applicants respectfully submit that no *prima facie* case of obviousness has been made and the §103(a) rejection is improper.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. *In re Grabiak*, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. *Id.* The absence of such a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1352 (Fed. Cir. 2001). In each case the factual inquiry whether to combine references must be thorough and searching. *Id.*, at 1352 - 53.

2.(a).(ii) Independent Claims 1, 44, 45, and 55

Each of independent claims **1, 44, 45, and 55** recite the following features (or substantially similar features), which are not taught or suggested by either Rose or Roberts, alone or in combination:

- distributing an image of a shopper to a plurality of participants.

Examiner asserts that Roberts teaches the above feature. Applicants respectfully disagree. Roberts does teach allowing two or more users to view Internet multi-media content simultaneously. However, such Internet multi-media content is not an image of a shopper. There is no disclosure in Roberts suggesting that such content can be an image of a shopper. Further, a participant has been defined by Applicants as “an individual who responds to a shopper’s request for an opinion or who indicates a willingness to respond to shoppers’ requests for opinions.” (top of pg. 9 of the specification as filed). Roberts does not disclose that any individual who may view Internet multi-media content falls within this definition of “participant”. Rather, Roberts discloses that the Internet multi-media content can be viewed by a customer or a customer service representative. A customer service representative is not an individual who provides opinions to customers but is rather an individual who aids customers in obtaining products, services, or information.

Regarding claim 45 in particular, Applicants traverse Examiner’s assertion that “Roberts teaches the kiosk and the panel of participants as recited in the claims (col. 5, lines 10 – 18). Paper No. 5, page 5, end of last paragraph). The passage of Roberts cited by Examiner, as well as the remainder of Roberts, discloses that a user at a first computer may communicate with a customer service representative of a second computer. There is no disclosure of a kiosk in Roberts, much less a kiosk that is operable to control an image means to capture an image of a shopper and a display means for displaying responses from a plurality of participants to the shopper, as is claimed.

2.(a).(iii) Dependent Claims 2, 4 – 9, 14 – 17, 22 – 24, and 46

Since each of claims 2, 4 – 9, 14 – 17, and 22 – 24 is dependent from claim 1 and claim 46 is dependent from claim 45, Applicants respectfully submit that each of the dependent claims 2, 4 – 9, 14 – 17, 22 – 24, and 46 is patentable at least for the same reasons as discussed with respect to claims 1 and 45 (no

prima facie case of obviousness has been made and the references do not teach all of the features of the independent claims). Additionally, Applicants traverse below some of Examiner's assertions regarding these dependent claims on distinct and additional grounds.

In discussing the rejection of claims **1, 44, 45, and 55**, Examiner asserts on the bottom of pg. 3 through the top of pg. 4 of the Current Office Action, that Rose teaches the following (with corresponding portions of Rose cited by Examiner in support of each assertion):

- (i) the shopper dons the selected garment (col. 1, lines 57 – 63; col. 3, line 63 – col. 4, line 24; Figures 1 – 4);
- (ii) optical system to capture an image of the shopper (col. 3, lines 19 – 20, col. 3, lines 56 – 59); and
- (iii) digital camera (col. 3, lines 56 – 59).

As a preliminary matter, Applicants note that none of the above features that are discussed in support of the rejection of claims **1, 44, 45, or 55** (or in claim **56**, which the above assertions are made in support of the rejection of) are recited in any of these claims. However, since the features are claimed in dependent claims **6, 8, 9, and 46**, Applicants respond to Examiner's assertions herein.

Regarding the assertion that Rose teaches that “the shopper dons the selected garment”, none of the passages of Rose cited by Examiner, nor the remainder of Rose, teaches or suggests such a feature. Rose is a self-described “method for electronic shopping” where a customer, via a computer terminal, inputs personal information (such as the customer's body measurements and fashion preferences) and, based on this information, selecting fashions for the customer. At most, the passages cited by Examiner, disclose that the electronic system provides a recommendation of a fashion to the customer. There is no disclosure in Rose that the customer ever “dons” a garment.

Regarding the assertions that Rose teaches “optical system to capture an image of the shopper” and “a digital camera”, Rose merely discloses that a customer may submit a photograph of the customer's face along with other

personal data. The system of Rose does not include an optical system to capture an image of a shopper. However the customer obtains the photograph to submit to the system, there is no disclosure in Rose that the system itself include any component operable to capture an image of the shopper.

Applicants also respectfully traverse the following assertions regarding the teachings of Roberts:

Regarding claim 15, Applicants respectfully disagree that Roberts discloses accumulating the responses received from the plurality of participants. Not only is there no disclosure in Roberts of accumulating responses from one or more users, it would not make sense to accumulate such responses. Roberts repeatedly emphasizes the importance of almost immediately conveying to a second user a first user's modification of the Internet multi-media contents being viewed by the two users. The customer and the customer service representative are each presented with a shared view, and any changes made by one are immediately conveyed to the other. Otherwise, the view would not be a shared view and the two would be looking at different contents, which would render unattained a goal of the invention. Thus, any responses in Roberts are immediately implemented rather than being accumulated.

Regarding claim 22, Applicants respectfully disagree that Roberts discloses transmitting a promotional offer to the shopper (allegedly disclosed in col. 2, lines 59 – 61). First, Applicants note that claim 22 recites “transmitting a promotional offer to the shopper *together with the received responses*” (emphasis added) and not just “transmitting a promotional offer to the shopper”. Roberts does not disclose providing a promotional offer to a user together with received responses. First, the passage of Roberts cited by Examiner merely discloses that a product may be advertised to a customer while the customer is on hold. As another passage of Roberts makes clear (col. 5, lines 10 – 51), a user is on hold while an available customer service representative is located. Thus, the advertisement that is provided to a user in Roberts is provided before any responses to an image are received since it is provided before the user and customer service representative view Internet multi-media content together.

Accordingly, the advertisement cannot be provided to the user “together with the received responses”. Second, an advertisement is not an offer for anything but is rather a solicitation for offers.

Regarding claim 23, Applicants respectfully disagree that Roberts discloses that the promotional offer is determined based on an analysis of the received responses (allegedly disclosed in col. 11, line 53 – col. 12, line 14). As discussed above with respect to claim 22, an advertisement in Roberts (even if it were characterized as a promotional offer) is provided before any responses are received. Thus, it cannot be provided based on an analysis of any responses. Further, Roberts does not disclose or suggest basing any advertisement, much less a promotional offer, on a received response.

Regarding claim 24, Applicants respectfully disagree that Roberts discloses transmitting the received responses to a retailer. Roberts merely discloses adjusting a view of a first user based on a modification made by a second user (and vice versa). There is no disclosure in Roberts that any modifications or responses of a user are provided to a retailer.

2.(a).(iv) Independent Claim 56

First, as the motivation to combine Rose with Roberts provided in support of the §103(a) rejection of claim 56 is the same as that provided for claims 1, 44, 45, and 55, Applicants respectfully submit that Examiner has not met the burden of establishing a motivation to combine Rose with Roberts in support of the rejection of claim 56. The reasons for this failure are the same as those discussed with respect to claims 1, 44, 45, and 55 and will not be repeated in detail herein for purposes of brevity. In summary, the motivation to combine is improper because no factual findings in the record have been made of why one of ordinary skill in the art would have made the combination, and the combination does not address or result in the claimed embodiments.

Second, Applicants traverse the §103(a) rejection of claim 56 based on the combination of Rose and Roberts on the additional grounds that neither Rose or

Roberts, alone or in combination, teaches or suggests the following features of claim 56:

- requesting a panel of participants; and
- receiving feedback regarding the garment based on responses from the panel of participants.

Examiner asserts that Roberts teaches the “requesting a panel of participants” feature at col. 3, line 58 – col. 4, line 3 and col. 5, lines 10 – 17. Applicants respectfully disagree. The passages cited by Examiner, and the remainder of Roberts, merely state that one-to-many communication between one user computer and more than one second computer are possible. However, this does not support the proposition that Roberts teaches requesting a panel of participants. Rather, Roberts discloses that a server may select the queue of a customer service representative into which to place a customer’s call (col. 5, lines 19 – 31) based on a variety of factors, none of which are a request. There is no request of a panel of customer service representatives, much less a panel of participants, being received.

Examiner further asserts that Roberts teaches “receiving feedback regarding the garment based on responses from the panel of participants.” This claim feature does not appear to be directly addressed by Examiner in the current Office Action. However, Applicants have carefully reviewed Roberts and submit that Roberts does not disclose such a feature. Roberts teaches that a customer or customer service representative may modify Internet multi-media content being viewed simultaneously by the customer and customer service representative. However, there is no disclosure or suggestion of either party requesting any feedback regarding such multi-media content being viewed, much less “feedback regarding a garment based on responses from a plurality of participants.” If Examiner maintains the rejection of claim 56, Applicants respectfully request that Examiner provide a citation to the section of Roberts that allegedly discloses this feature or reasoning why it would be obvious to modify Roberts to disclose the feature.

2.(a).(v) Dependent Claims 58 - 59

Claims **58 and 59** are each dependent from claim **56**. Accordingly, Applicants respectfully submit that claims **58 and 59** are each patentable at least for the same reasons discussed with respect to claim **56**.

Claim **59** in particular is also patentable because neither Rose nor Roberts teaches or suggests “capturing an image of a shopper.” Rose at most discloses that a customer may submit a previously taken photograph of the customer’s face to the system. However, Rose does not teach that the system is capable of capturing the image of the shopper. Roberts does not address an image of a shopper at all.

2(b). Claims 3, 10 – 13, 18 – 21, 25 – 27 and 57

Claims **3, 10 – 13, 18 – 21, 25 – 27 and 57** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rose and Roberts in further view of U.S. Patent No. 5,913,204 to Kelly (“Kelly” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

Claims **3, 10 – 13, 18 – 21, and 25 – 27** are each dependent from claim **1**. Claim **57** is dependent from claim **56**. Accordingly, Applicants respectfully submit that these claims are each patentable at least for the same reasons as claim **1 and 56**, respectively.

Additionally, Applicants respectfully submit that no proper motivation to combine Rose and Roberts with Kelly has been provided and thus a *prima facie* case of obviousness has not been established for claims **3, 10 – 13, 18 – 21, 25 – 27, and 57**.

The following statement has been provided as the motivation to combine Rose and Roberts with Kelly:

“It would have been obvious...to modify the method of the combination of Rose and Roberts, to include the performing of statistical analysis of the received responses and the assembling, selecting, and rating of participants, as taught by Kelly, *in order to provide prospective participants who comply with the defined*

criteria (Kelly col. 3, lines 47 – 50).” Paper No. 5, page 8, first paragraph, emphasis added.

The discussion of why no proper motivation to combine Rose and Roberts was provided is applicable here and will not be discussed for purposes of brevity but is instead incorporated by reference. The proposed motivation to combine Kelly with the combination of Rose and Roberts is also flawed. The motivation is a direct quote from Kelly, where it is described that the Kelly system may use census data “to further tailor lists of prospective listeners to increase the likelihood of reaching prospective survey participants who comply with the defined listener data” (col. 3, lines 47 – 50). Since the Kelly system self-professes to satisfy the goal provided as the motivation to combine, this goal would not cause one to seek out another method of meeting the goal, much less the particular method of Rose, Roberts, or a combination thereof. Further, Examiner provides no reason of why one of ordinary skill in the art would recognize to combine Rose and Roberts with Kelly based on this statement in Kelly. In essence, Examiner’s statement merely appears to state that the references should be combined because a desirable effect and a claimed feature would result. This is not a proper finding of a motivation to combine, as discussed in detail above, and appears to merely use Applicants’ disclosure against Applicants, which is prohibited by case law.

Additionally, Applicants traverse the §103(a) rejection of claims **3, 10 – 13, 18 – 21, 25 – 27 and 57** on the grounds that Kelly is non-analogous art to either Rose or Roberts, as well as to the claimed invention. Kelly addresses the field of “surveying music listener opinion of a list of songs such as the songs contained in a radio station music library” (col.1, lines 6 – 8, field of the invention) and addresses the problem of determining for a radio station listener opinions regarding songs played by the radio station. This is a distinct field from retail shopping and a distinct problem from that of Rose (providing fashion recommendations to shoppers), Roberts (allowing two users to view Internet multi-media content simultaneously), or the claimed embodiments of the present invention (enhancing the shopping experience). Thus, a person of ordinary skill in the art working in the field of Kelly or looking to solve the problem of Kelly would not

look to either Rose or Roberts (or vice versa) and Kelly has been improperly combined with Rose and Roberts.

Regarding claims **12 and 25**, even if the §103(a) rejection was not improper because the motivation to combine was not improper and the art were analogous, Applicants further traverse the rejection on the grounds that Kelly fails to disclose the claimed features.

Claim **12** recites the feature of “wherein the characteristics of the participants include subjective characteristics defined by the participants”. That is, the participants that are being selected define subjective characteristics. Kelly does not disclose that the music listeners who are being selected for a survey define any characteristics, much less subjective characteristics. The radio station or entity sponsoring the survey defines the characteristics in Kelly and the listeners merely provide the appropriate information for each characteristic so defined but do not themselves define any characteristics. It appears that Examiner may have inadvertently mischaracterized claim **12** as reciting merely that “the characteristics of the participants include demographic and subjective characteristics of the participants.” Paper no. 5, pg. 7, middle of first full paragraph. However, as noted above, the feature of claim **12** is actually that the characteristics of the participants include subjective participants defined by the participants, which is not taught or suggested by Kelly.

Claim **25** recites the feature of “applying a rating to at least some of the participants on the basis of the received responses.” Kelly does not disclose applying a rating to a listener. Kelly merely discloses determining a rating for a song (but not for the listener who’s opinion was used in determining the rating for the song).

2.(c). Claims 28 – 39, 42 – 43, 48 – 54 and 60 – 62

Claims **28 – 39, 42 – 43, 48 – 54 and 60 – 62** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rose in view of Roberts and further in view of Kelly. Applicants respectfully traverse the rejection of these claims for the reasons set forth below.

As with claims **3, 10 – 13, 18 – 21, 25 – 27 and 57**, Applicants respectfully submit that the §103(a) rejection of claims **28 – 39, 42 – 43, 48 – 54 and 60 – 62** is

improper because (i) the burden of establishing a *prima facie* case of combining the combination of Rose and Roberts with Kelly has not been met, and (ii) Kelly is non-analogous art and thus has been improperly included in the combination. The detailed discussion of these reasons will not be repeated herein but is instead incorporated by reference herein from section 2(b).

Applicants further submit that the motivation to combine Kelly with the combination of Rose and Roberts, as stated in support of the rejection of claims 28 – 39, 42 – 43, 48 – 54 and 60 – 62 is even more flawed than the motivation to combine the same references as stated with claims 3, 10 – 13, 18 – 21, 25 – 27 and 57 because the motivation provided with respect to claims 28 – 39, 42 – 43, 48 – 54 and 60 – 62 (paper no. 5, pgs. 9, 11, 12, and 14) is completely devoid of any statement or reasoning of why one of ordinary skill would have combined Kelly with the combination of Rose and Roberts. Rather, the statement of the motivation to combine Kelly with Rose and Roberts is merely a verbatim repetition of the motivation to combine Rose with Kelly. Accordingly, Examiner has provided absolutely no motivation to combine Kelly with Rose and Roberts with respect to the rejection of claims 28 – 39, 42 – 43, 48 – 54, and 60 – 62.

2.(c).(i) Independent Claim 28

Applicants further traverse the §103(a) rejection of independent claim 28 on the grounds that, even if the §103(a) rejection was proper, the combination of Rose, Roberts, and Kelly fails to teach the following feature of claim 28:

- transmitting the combined image [of the shopper and the selected garment] to participants determined to be available.

Applicants discussed in detail why neither Roberts nor Rose teaches or suggests this feature with respect to claims 1, 44, 45, and 55 (section 2(a)(ii) above). The arguments regarding this feature are incorporated by reference herein from section 2(a)(ii) and will not be repeated for purposes of brevity. Kelly also does not teach or suggest this feature since Kelly is completely devoid of any reference to transmitting any image to participants, much less an image of a shopper combined with a selected garment.

2.(c).(ii) Dependent Claims 29 – 36

Dependent claims **29 – 36** are each dependent from claim **28** and are thus patentable at least for the same reasons as discussed with reference to claim **28**.

2.(c).(iii) Independent Claim 37

Applicants further traverse the §103(a) rejection of independent claim **37** on the grounds that, even if the §103(a) rejection was proper, the combination of Rose, Roberts, and Kelly fails to teach the following features of claim **37**:

- capturing an image of a shopper who is wearing a garment; and
- transmitting the image to the panel of participants.

As discussed in section 2(a)(iii) above, neither Rose nor Roberts teaches or suggests a system that includes a component operable to capture an image of a shopper or a step of capturing an image of a shopper. The arguments in support of this assertion will not be repeated herein but are incorporated by reference from section 2(a)(iii) above for purposes of brevity. Kelly also does not teach or suggest capturing an image of anything, much less an image of a shopper, since Kelly addresses mailed surveys to radio music listeners.

As discussed in section 2(a)(ii) above, neither Rose or Roberts teaches or suggests transmitting an image [of a shopper] to a panel of participants. The arguments in support of this assertion will not be repeated herein but are incorporated by reference from section 2(a)(ii) above for purposes of brevity. Kelly also does not teach or suggest transmitting an image of a shopper to any entity, since Kelly does not address shopping or shoppers in any manner.

2.(c).(iv) Dependent Claims 38, 39, 42, and 43

Dependent claims **38, 39, 42, and 43** are each dependent from claim **37**. Accordingly, Applicants respectfully submit that each of claims **38, 39, 42, and 43** is patentable at least for the same reasons as discussed with reference to claim **37**.

2.(c).(v) Independent Claim 48

Applicants further traverse the §103(a) rejection of independent claim 48 on the grounds that, even if the §103(a) rejection was proper, the combination of Rose, Roberts, and Kelly fails to teach the following features of claim 48:

- distributing the image of the shopper to the selected panel of participants

As discussed in section 2(a)(ii) above, neither Rose or Roberts teaches or suggests distributing an image of the shopper to a panel of participants. The arguments in support of this assertion will not be repeated herein but are incorporated by reference from section 2(a)(ii) above for purposes of brevity. Kelly also does not teach or suggest transmitting an image of a shopper to any entity, since Kelly does not address shopping or shoppers in any manner.

2.(c).(vi) Dependent Claims 49 – 54

Dependent claims 49 – 54 are each dependent from claim 48. Accordingly, Applicants respectfully submit that each of claims 49 – 54 is patentable at least for the same reasons as discussed with reference to claim 48.

Regarding claim 54, Applicants traverse the rejection of this claim on the additional grounds that none of the references teach or disclose “using an optical system to capture an image of the shopper.” As discussed in detail in section 2(a)(ii), the relevant arguments from which are incorporated by reference herein for purposes of brevity, neither Rose nor Roberts teaches or suggests capturing an image of a shopper or a component operable to capture an image of a shopper. Kelly also does not disclose this feature since Kelly does not disclose any means operable to capture an image of any person, much less a shopper, and does not address shoppers or capturing images of shoppers in any context.

2.(c).(vii) Independent Claim 60

Applicants further traverse the §103(a) rejection of independent claim **60** on the grounds that, even if the §103(a) rejection was proper, the combination of Rose, Roberts, and Kelly fails to teach the following features of claim **60**:

- receiving a message that includes an image of a shopper.

As discussed in detail in section 2(a)(ii), the relevant arguments from which are incorporated by reference herein for purposes of brevity, neither Rose nor Roberts teaches or suggests transmitting an image of a shopper to a participant. Accordingly, as claim **60** is a method from a participant's perspective, neither Rose or Roberts teaches receiving a message that includes an image of a shopper. Kelly also does not disclose this feature as Kelly does not address receiving an image of any person, much less a shopper, in any context.

2.(c).(viii) Dependent Claims 61 and 62

Dependent claims **61 and 62** are each dependent from claim **60**. Accordingly, Applicants respectfully submit that each of claims **61 and 62** is patentable at least for the same reasons as discussed with reference to claim **60**.

2(d). Claims 41 and 42

Claims **41 and 42** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rose in view of Roberts, further in view of Kelly and further in view of U.S. Patent No. 6,134,548 to Gottzman ("Gottzman" herein). Applicants respectfully traverse this rejection for the reasons set forth below.

Each of claims **41 and 42** is dependent from independent claim **37**. Accordingly, Applicants respectfully submit that each of claims **41 and 42** is patentable at least for the same reasons as discussed with reference to independent claim **37**.

Applicants additionally traverse the §103(a) rejection of claims **41 and 42** on the grounds that the motivation to combine Gottzman with Rose, Roberts, and Kelly is not sufficient to meet Examiner's burden of establishing a prima facie case of obviousness

for claims **41 and 42**. Examiner has merely provided the following conclusory statement as the motivation to make the combination:

“It would have been obvious...to modify the combination of Rose, Roberts, and Kelly to have include [sic] the product identifier code and the scanning of a bar code, as taught by Gottsman, *in order to find the availability and pricing information of the product.*” Paper No. 5, pg. 15, end of paragraph running over from page 14, emphasis added.

This statement is, first of all, simply a quote of a result accomplished by Gottsman. Accordingly, as discussed in section 2(a)(i) above, such a statement would not cause one to seek out another method of accomplishing the result, much less the particular method of Rose, Roberts, or Kelly. Further, the statement is merely a statement of a desirable result that may be achieved from the combination and appears to use Applicants’ teachings against Applicants. This is insufficient as a motivation to combine since it does not explain what in the references or knowledge in the art would have motivated one of ordinary skill in the art to make the proposed combination without the benefit of having first read Applicants’ disclosure. Further, such a statement is prohibited by case law because it is based on hindsight.

Applicants further traverse the §103(a) rejection of claims **41 and 42** on the additional grounds that Gottsman is non-analogous art to Rose, Roberts, Kelly, and the present invention. Gottsman is directed to the field of “mobile computing environment that accesses the Internet to obtain product information for a user.” (col. 1, lines 8 – 10, field of the invention) and addresses the problem of facilitating web-based comparison shopping. This field and problem are non-analogous to the fields and problems addressed by Rose, Roberts, Kelly, and the present invention and thus the combination of Gottsman with these references is improper.

2(e). Claim 47

Claim 47 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Rose in view of Roberts and further in view of Gottzman. Applicants respectfully traverse this rejection for the reasons set forth below.

Claim 47 is dependent from independent claim 45. Accordingly, Applicants respectfully submit that the claim 47 is patentable at least for the same reasons discussed with respect to claim 45.

Applicants additionally traverse the §103(a) rejection of claim 47 on the grounds that the motivation to combine Gottzman with Rose and Roberts is improper for the same reasons that the motivation to combine Gottzman with the combination of Rose, Roberts, and Kelly (discussed in section 2(d) above and incorporated by reference herein for purposes of brevity).

Applicants additionally traverse the §103(a) rejection of claim 47 on the grounds that Gottzman is non-analogous art to Rose and Roberts, as discussed in section 2(d) (the arguments of which are incorporated by reference herein for purposes of brevity) above and thus the combination is improper.

CONCLUSION

For the foregoing reasons it is submitted that all of the claims pending after the amendments made herein are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

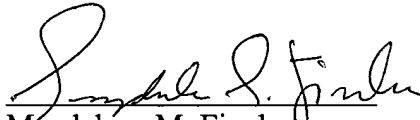
Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number 203-461-7041 or via electronic mail at mfincham@walkerdigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a **three-month** extension of time with which to respond to the Office Action. Please charge \$475.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required in addition to that requested in this petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



Magdalena M. Fincham
Attorney for Applicants
Registration No. 46,085
Walker Digital, LLC
Mfincham@walkerdigital.com
(203) 461-7041/voice
(203) 461-7300/fax

October 31, 2003
Date